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PATENT
CUSTOMER NUMBER, 34,986
Docket No. 01064.0011-08-000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:
Richard LEVY
Serial No.: 10/614,114
Filed: July 7, 2003
For: SUPERABSORBENT POLYMER
COMPOSITIONS ON A
SUBSTRATE (AS AMENDED)

Group Art Unit: 1774

Examiner: Jill Gray

**Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450**

Sir:

APPELLANT'S BRIEF ON APPEAL PURSUANT TO 37 C.F.R. § 41.37

The examiner, rather than submitting an Examiner's Answer in response to appellant's February 2, 2006 appeal brief, reopened prosecution of this application with the second non-final rejection of April 19, 2006. Appellant submits the following brief to perfect the appeal filed on April 28, 2006 in response to the rejection of April 19, 2006. The brief sets forth the authorities and arguments on which appellant will rely to maintain the appeal. The Code of Federal Regulations, 37 C.F.R. § 41.20 (b) (2), requires payment of a \$250.00 fee for filing this brief; however, appellant filed the appeal brief of February 2, 2006 with an appeal fee of \$250.00. The Manual of Patent Examining Procedure § 1204.01 waives payment of the \$250.00 fee in these circumstances.

(i) Real party in interest

The inventor assigned the parent application Serial No. 08/487,436, filed June 7, 1995 to Lee

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County Mosquito Control District. The assignment was recorded at reel 7878, frame 0620 on August 23, 1995, which makes Lee County Mosquito Control District the real party in interest.

(ii) Related appeals and interferences

Appellant has co-pending appeals before the Board of Patent Appeals and Interferences in the following related applications:

Serial No. 10/614,114 Filed July 7, 2003 (Attorney Docket 01064.0011-08-0000)

Serial No. 09/359,809 Filed July 23, 1999 (Attorney Docket 01064.0011-05-0000)

The Board of Patent Appeals and Interferences rendered a decision in an appeal on application Serial No. 08/943,125 Filed October 3, 1997 on February 27, 2006, reversing the examiner in all respects, but remanding the application to the examiner for further action. The Patent Office, however, labeled the file jacket of that application as follows:

U. S. PATENT AND TRADEMARK OFFICE

RETURN TO (PTO 1056)

INTERFERENCE SERVICE BRANCH

This case is involved in an

Interference Proceeding

Appellant includes in section "(x) Related proceedings appendix" of this brief the Board's February 27, 2006 decision in application Serial No. 08/943,125 and a certified copy of the file

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jacket of that application showing the foregoing label regarding the interference. Appellant also included that label as an attachment to appellant's brief in Serial No. 08/943,125.

The Patent Office has not notified appellant that they have declared an interference in any of the foregoing applications, even though they indicated on the file of application Serial No. 08/943,125 "[t]his case is involved in an Interference Proceeding." The Board also took the position, when contacted by appellant's attorneys by telephone, that the Patent Office had not declared an interference, in application Serial No. 08/943,125. Lastly, the Board's decision in the pending appeal could directly affect, or be directly affected by, or having a bearing on the decision in the co-pending appeals.

(iii) Status of Claims

The application contains claims 57-63, 65-71, 73, 76, and 87-91.

(iv) Status of Amendments

The examiner has entered and considered all amendments filed in this application.

(v) Summary of Claimed Subject Matter

The invention of independent claim 57 comprises a substrate coated with a substantially water free composition (written description, page 20, paragraph bridging pages 31-32) comprising a superabsorbent polymer that absorbs greater than about 100 times its weight in water (written description, paragraph bridging pages 22-23) with a material for decreasing friction between moving surfaces. This material comprises a lubricating metal, and alloy thereof, lubricating metal chalcogenide, halide, carbonate, silicate, phosphate, or a particulate lubricating

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metal nitride, carbon lubricant, silicate ester, polyphenyl ether, organic phosphate; biphenyl, phenanthrene or phthalocyanine compound. It may optionally contain a lubricant comprising an organic lubricant, inorganic lubricant or a lubricant additive, or mixtures thereof. The written description supports the organic lubricants at pages 6-14 and the paragraph bridging pages 25-26, whereas pages 15-18 support inorganic lubricants, additives at page 25, first full paragraph, lubricant additives specifically at pages 7-10, and mixtures at page 26, second full paragraph inter alia. In addition, original claims 6, 10, and 14 also support the amendments to the claims that describe the material for lubricating a surface.

Independent method claim 65 describes the use of the foregoing composition to protect a substrate from the affects of water. Page 39 of the written description, last sentence, describes the composition as useful for protecting substrates from the "affects of water or water migration."

(vi) Grounds of Rejection to be Reviewed on Appeal

- a. Whether claims 62 and 70 allegedly fail to comply with the requirement under 35 U.S.C. § 112, first paragraph that the written description convey to a person with ordinary skill in the art that the inventor, at the time he filed the application, was in possession of the invention comprising the coating applied to a substrate comprising a cable?
- b. Whether claim 91 is indefinite under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter of the invention as lubricants that "comprise" some named materials rather than

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lubricants "consisting essentially of" such materials.

- b. Whether claims 57-63, 65-71, 73, 76, and 87-91 are obvious under 35 U.S.C. § 103 (a) and therefore unpatentable in view Petinelli et al. United States Patent No. 4,621,169 ("Petinelli") in view of Freeman, United States Patent No. 5,218,011 and Marciano-Agostinelli et al., United States Patent No. 5,049,593 (Marciano-Agostinelli).

(vii) Argument

The Rejection of Claims 62 and 70 Under 35 U.S.C. § 112 First Paragraph

The examiner rejects claims 62 and 70 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the requirement that the written description convey to a person with ordinary skill in the art that the inventor was in possession of the invention comprising the coating applied to a substrate comprising a cable at the time he filed the application. The examiner argues that the application does not describe the substrate as a cable.

The examiner's position that "the specification as originally filed only teaches polyisobutylene as a lubricant for cable applications" (April 19, 2006 Office Communication, p. 3, 1st par.) fails to acknowledge appellant's disclosure that the present invention provides another "lubricant" for this "related art" cable lubricant, namely, the lubricants appellant discloses in his application, and now claims.

The examiner overlooks appellant's written description that clearly teaches the present invention provides compositions in addition to polyisobutylene lubricants for application to cables. The application clearly states:

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[f]or the purpose of the present invention, all of the foregoing lubricant compounds or composition will be referred to as materials for decreasing friction between moving surfaces or lubricants.

From the foregoing, it should be apparent that there is a need for additional materials that will provide the same advantages as those of the related art as well as additional advantages and also materials that will overcome some of the various disadvantages of the related art. . . .

These and other advantages are obtained according to the present invention, which is the provision of a composition and a process to enhance the various advantages of the related art and which also substantially obviate one or more of the limitations and disadvantages of the described prior compositions of matter and processes. . . .

To achieve these and other advantages, and in accordance with the purpose of the invention, as embodied and broadly described, the invention comprises a lubricant composition of matter comprising a superabsorbent polymer combined with a material for decreasing friction between moving surfaces or a lubricant as described herein. . . .

(Written description, pp. 19-20). One "lubricant as described" in the application comprises a cable lubricant (written description, page 12, line 6 from the bottom), which the appellant clearly states "will provide the same advantages as those of the related art [e.g., cable lubricants] as well as additional advantages and also materials that will overcome some of the various disadvantages of the related art [cable lubricants]. . . ." (Written description, p. 20). The "lubricants" of the invention used for these cable lubricants comprise those described at pages 6-20 of the written description which clearly support the lubricants now claimed.

. Finally, appellant at the time of filing the application disclosed a coating of the lubricants of the invention on a cable inter alia by stating the invention also includes a method for

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lubricating a surface with appellant's lubricants. The application notes in this regard "[t]he invention also comprises a method of lubricating a surface comprising coating the surface with a lubricating composition comprising a superabsorbent polymer combined with a material for decreasing friction between moving surfaces as described herein. . ." (Written description, p. 20). As acknowledged by the examiner, appellant also disclosed one of the related art surfaces as a "cable," and it is impossible to have a method that employs appellant's lubricants for coating a related art surface such as a "cable" without producing a "cable" coated with appellant's lubricants.

Appellant did not originally claim the cable substrate, even though he disclosed it, nor for that matter, appellant's presently claimed lubricants, which he also disclosed. Rather he amended the application during prosecution to claim these features and now includes both for what he regards as one aspect of his invention, but he can do this since "[t]he second paragraph of 35 U.S.C. 112 does not prohibit applicants from changing what they regard as their invention during the pendency of the application. . ." (Manual of Patent Examining Procedure ("M.P.E.P.") § 2172 (III)) (citations omitted).

The Rejection of Claim 91 Under 35 U.S.C. § 112 Second Paragraph

The examiner rejected claim 91 under 35 U.S.C. § 112, second paragraph because the claim allegedly uses improper Markush language. The examiner recommended appellant employ the terminology "selected from the group consisting of," apparently referring to the claim 91 term "comprises" in the phrase "wherein said: (1) lubricating metal and alloy thereof, lubricating metal chalcogenide halide, carbonate. . . comprises: molybdenum disulfide, cobalt .

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chloride. . . ." (Emphasis added).

In claiming the invention using the well-known term "comprises," appellant follows the practice set out in the M.P.E.P. which states:

[a] fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographer. They can define in the claims what they regard as their invention essentially in whatever terms they chose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. . . . [A] claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

(M.P.E.P. § 2173.01) (citation omitted). Specifically, appellant uses the term "comprises" in a way that is not contrary to accepted meaning and which does not contravene the requirement that he make clear the boundaries of the subject matter of the invention for which he seeks protection. "Comprising' is a term of art used in claim language. . ." and its meaning is well defined by case law. (M.P.E.P. 2111.03) (citations omitted).

The Rejection under 35 U.S.C. § 103 (a) and Traverse

The examiner rejects claims 57-63, 65-71, 73, 76, and 87-91 under 35 U.S.C. § 103 (a) as unpatentable over Petinelli, Freeman, and Marciano-Agostinelli.

The examiner, citing Petinelli for the first time in her April 19, 2006 Office Communication, takes the position it discloses a cable and wire substrate coated with an essentially water-free composition that also includes a metal or metal oxide or carbon, as well

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as the organic lubricant claimed by appellant. She now relies on Petinelli since the previous rejection did not cite references to show some of the inorganic materials appellant claims. She also acknowledges Petinelli does not teach superabsorbent polymers, but cites Freeman to show these materials.

Freeman, according to the examiner, provides the motivation for combining its teachings with Petinelli since it discloses a water-free gel composition for protecting a wire or cable substrate from damage caused by water, where the gel composition contains superabsorbent polymers combined with silicones, petroleum gels, esters, glycols, olefins, mineral oils and fluorocarbons.

The examiner also cites Marciano-Agostinelli to address the superabsorbent polymer water absorbing properties of the composition of the invention, as well as the polymer particle size parameters of claims 73, 76, and claims dependent thereon, acknowledging Freeman does not describe these parameters. In relying on Marciano-Agostinelli, the examiner did not formally reject any of the claims based on this reference, either alone or in combination with Petinelli, or Freeman, but refers to it in her detailed comments.¹

Obviousness Rejections Under 35 U.S.C. § 103

The Examiner "has to point to some teaching, [or] suggestion. . . in the prior art to select and combine the references that . . . [she] relied on to show obviousness." In re Lee, 227 F.3d 1338, 61 U.S.P.Q. 1430, 34 (Fed. Cir., 2002) (emphasis added). "When patentability turns on

¹ April 19, 2006 Office communication, p. 4, 2nd full par., and pp.4-6.

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the question of obviousness, the search for and analysis of the prior art includes evidence relevant to select and combine the references relied on as evidence of obviousness... 'the central question is whether there is a reason to combine references.' Lee, 61 U.S.P.Q. at 1435 (emphasis added) (citation omitted). In re Kahn, No. 04-1616, Fed. Cir. March 22, 2006. The references also have to provide some motivation for the skilled artisan to combine their teachings. Id.

The combination of references does not make appellant's invention obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01 citing In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2nd 1430 (Fed. Cir. 1990). In addition, there must be some reasonable expectation of success (M.P.E.P. § 2143.02, citing In re Merck & Co., Inc. 800F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986)) and that some advantage or expected beneficial result would have been produced by their combination. (M.P.E.P. § 2144 citing In re Sernaker, 702 F.2d, 989, 994-95, 217 U.S.P.Q. 1, 5-6 (Fed. Cir. 1983)). Lastly, the prior art references must teach or suggest all of appellant's claim limitations. (M.P.E.P. §§ 2143 and 2143.03, and In re Royka, 490 F. 2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974) cited in M.P.E.P. § 2143.03.) Appellant submits that the Examiner has not pointed to anything in the cited references that would lead a person with ordinary skill in the art to combine their teachings.

Arguments

Appellant does not dispute that both Petinelli and Freeman disclose cable or wire coatings, but the similarity stops there. The references provide no motivation, suggestion or teaching for combining them under 35 U.S.C. § 103 (a) for the purpose of an obviousness

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rejection. In fact, the references taken together would lead a person of ordinary skill in the art away from appellant's invention.

Petinelli in this regard, although teaching a coating for a cable, describes some of the difficulties in protecting the cable from water. The inventor notes:

[t]he region between the semiconducting polymer. . . and the metallic shield. . . is always apt to allow traces of moisture to come into contact with the metal, thus causing the latter to deteriorate by a process of disintegration, oxidation and/or corrosion. This drawback can be partially limited by incorporating between the metallic sheath and the semiconducting polymer, a layer of a hydrophilic material such as carboxymethylcellulose or of a hygroscopic material such as a semiconducting clay whose swelling in the presence of moisture will prevent the water from spreading along the conducting metal. However, these products will not prevent local corrosion of the shields. . .

[T]he invention [therefore] has as its object an electric cable construction of the type comprising at least one metallic shield and at least one semiconducting polymer layer which surround at least one cable conductor, characterized in that between said metallic shield and said semiconducting polymer layer there is interposed a moistureproofing [sic] layer comprising a semiconducting and hydrophobic gel.

(Petinelli, par. bridging cols. 1 and 2, Col. 2, lines 13-21) (Emphasis added).

In sum, Petinelli states he avoids corrosion caused by prior art "hydrophilic material" or "hygroscopic material" by employing a composition having just the opposite properties, i. e., a "hydrophobic gel." But the superabsorbent polymers of Freeman that the examiner would have the skilled artisan use in lieu of the "hydrophobic gel" of Petinelli absorb water!² They are diametrically opposed. Why on the one hand would the skilled artisan avoid water absorption and water corrosion with the "hydrophobic gel" of Petinelli, just to eliminate that advantage by

² Freeman, Col. 5, line 57 through Col. 6 line 34.

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substituting the water absorbing polymer of Freeman for it? She or he would not because the combined teachings of Petinelli and Freeman lead away from making this substitution.

Freeman, although describing superabsorbent polymers at column 7, lines 21 et seq., lines 29 et seq. and Lines 17 et seq., does not teach or suggest appellant's inorganic lubricants, but rather the following organic compounds at column 7, lines 20 et seq.:

silicones,
petroleum oils,
high viscosity esters,
polyglycols,
olefins,
fluorocarbons,
mixtures of,
polyalkylene glycols,
poly alpha-olefins,
polyisobutylene; and
mineral oils.

Appellant, however, claims inorganic lubricants, and none of these material comprise the inorganic lubricants claimed according to the present invention.

Freeman does not disclose the water absorbency of the polymer he employs. Appellant's polymer has to absorb at least 100 times its weight in water, but Freeman does not teach this water absorbency. Freeman's water absorbency could be only about 40 or 50, but the skilled artisan can make no determination of what the patentee required by way of water absorbency since the reference doesn't say anything in this regard. Freeman also does not

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show the particle size of appellant's superabsorbent polymer. The examiner therefore turns to Marciano-Agostinelli in an attempt to find these parameters.

The examiner cannot pluck appellant's water absorbency or the particle size of appellant's superabsorbent polymer out of Marciano-Agostinelli since, as appellant will show, Marciano-Agostinelli does not contain the requisite teaching or suggestion to combine its teachings with Freeman.

Marciano-Agostinelli describes a composition consisting of a mixture (column 3, lines 34 et seq.) of a superabsorbent polymer (column 5, lines 26 et seq.) and a "rubber" (column 5, lines 3 et seq.). Appellant does not employ "rubber" as a lubricant, and importantly none of the references relied on by the examiner teach or suggest that "rubber" comprises a material for lubricating a surface. To combine Freeman with Marciano-Agostinelli therefore would result in a composition containing some of the organic materials of Freeman (e.g., a silicone, a petroleum oil etc.), a superabsorbent polymer, also from Freeman, and a superabsorbent polymer and rubber from Marciano-Agostinelli. If the examiner makes the combination, she has to take the rubber of Marciano-Agostinelli as well, and appellant does not use rubber as a lubricant. Therefore, Marciano-Agostinelli standing alone, or in combination with Freeman does not make appellant's invention obvious.

In summary, the examiner agrees that appellant's written description discloses a coated cable. Pages 6-19 of the written description also describe the various lubricants used in combination with the superabsorbent polymer. Importantly, page 20 of the written description states that appellant's lubricant composition comprises a superabsorbent polymer in combination with lubricants described in the written description. The written description also

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discloses that one of the lubricants comprises cable lubricants. (written description, page 12, line 6 from the bottom). The application therefore supports the claims directed to the lubricant of the invention on a substrate comprising a cable in accord with 35 U.S.C. § 112, first paragraph.

The examiner recommended appellant employ the terminology "selected from the group consisting of," apparently referring to the claim 91 term "comprises" in the phrase "wherein said: (1) lubricating metal. . . comprises. . ." (Emphasis added). Appellant uses the term "comprises" in accord with accepted meaning. It does not contravene the requirement that he make clear the boundaries of the subject matter of the invention for which he seeks protection. "Comprising" is a term of art used in claim language. . ." and its meaning is well defined by case law. (M.P.E.P. 2111.03) (citations omitted). The claims therefore use the term "comprises" in accord with 35 U.S.C. § 112, second paragraph.

The examiner cannot support an obviousness rejection by combining the inorganic pigments of Petinelli's hydrophobic cable coating composition with the superabsorbent polymer of Freeman's hydrophilic cable coating composition to show appellant's invention, i. e., inorganic lubricants combined with superabsorbent polymers. The hydrophobic properties of Petinelli are diametrically opposed to the hydrophilic properties of Freeman, and when viewed in the context of these limitations they fail to provide any motivation, teaching, or suggestion to combine the teachings in a way leading to appellant's invention. On the contrary, they teach away from the invention.

As to Freeman in combination with Marciano-Agostinelli, there is no teaching, suggestion or motivation in the prior art to use the "rubber" of Marciano-Agostinelli in a

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lubricating material; the prior art does not include evidence relevant to select and combine the references, especially where common experience teaches rubber has just the opposite properties of a lubricant, i. e., there is no reason to combine the references because the examiner has not shown that "rubber" acts as a lubricant; the prior art does not show or suggest the desirability of the combination or reasonable expectation of success when using "rubber" in a composition for lubricating a surface; and that some advantage or expected beneficial result would have been produced by using "rubber" in a composition for lubricating a surface.

Additionally, Freeman and Marciano-Agostinelli, either taken alone or in combination with one another neither teach nor suggest appellant's substrate coated with the presently claimed composition, or a method for protecting a substrate from the affects of water or water migration by employing the presently claimed composition.

Appellant requests the Board to reverse the examiner in all respects and remand the application to the examiner for the issuance of a Notice of Allowance.

Respectfully submitted,

THE LAW OFFICES OF ROBERT J. EICHELBURG

Dated: June 6, 2006

By: /Robert J. Eichelburg, Reg. No 23,057/
Robert J. Eichelburg

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(viii) Claims appendix

Claims 1-56 (canceled without prejudice or disclaimer).

57: A substrate coated with an essentially water-free composition, wherein said composition comprises a superabsorbent polymer that absorbs greater than 100 times its weight in water in combination with a material for lubricating a surface wherein said material for lubricating a surface comprises:

- (1) a lubricating metal and alloy thereof, lubricating metal chalcogenide, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or
- (2) a silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound;
- (3) said material for lubricating a surface optionally containing a lubricant comprising an organic lubricant, inorganic lubricant, or a lubricant additive;
- (4) or mixtures thereof.

58: The substrate of claim 57 wherein said organic lubricant comprises a petroleum lubricant, synthetic lubricant, grease, or solid lubricant, or combinations thereof and wherein said additive comprises a detergent or a dispersant.

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59: The substrate of claim 57 wherein said superabsorbent polymer is neutralized or cross-linked, and is based on acrylic acid, acrylamide, or an acrylate.

60: The substrate of claim 58 wherein said superabsorbent polymer is neutralized or cross-linked, and is based on acrylic acid, acrylamide, or an acrylate.

61: The substrate of claim 57 wherein said organic lubricant comprises a petroleum oil, an organic ester, a silicone, or a glycol, or combinations thereof.

62: The substrate of claim 57 wherein said substrate comprises a cable.

63: The substrate of claim 57 wherein said substrate comprises a wire.

64 (canceled without prejudice or disclaimer).

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65: A method of protecting a substrate from the affects of water or water migration comprising coating said substrate with an essentially water-free composition, wherein said composition comprises a superabsorbent polymer that absorbs greater than 100 times its weight in water in combination with a material for lubricating a surface wherein said material for lubricating a surface comprises:

- (1) a lubricating metal and alloy thereof, lubricating metal chalcogenide, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or
- (2) a silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound;
- (3) said material for lubricating a surface optionally containing a lubricant comprising an organic lubricant, inorganic lubricant, or a lubricant additive;
- (4) or mixtures thereof.

66: The method of claim 65 wherein said organic lubricant comprises a petroleum lubricant, synthetic lubricant, grease, or solid lubricant, or combinations thereof, and said additive comprises a detergent or a dispersant.

67: The method of claim 65 wherein said superabsorbent polymer is neutralized or cross-linked, and is based on acrylic acid, acrylamide, or an acrylate.

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68: The method of claim 66 wherein said superabsorbent polymer is neutralized or cross-linked, and is based on acrylic acid, acrylamide, or an acrylate.

69: The method of claim 65 wherein said organic lubricant comprises a petroleum oil, an organic ester, a silicone, or a glycol, and combinations thereof.

70: The method of claim 65 wherein said substrate comprises a cable.

71: The method of claim 65 wherein said substrate comprises a wire.

72 (canceled without prejudice or disclaimer).

73: The substrate of claim 57 wherein the particle size of the superabsorbent polymer comprises from about less than 0.5 microns to about 300 microns.

Claims 74-75 (canceled without prejudice or disclaimer).

76: The method of claim 65 wherein the particle size of the superabsorbent polymer comprises from about less than 0.5 microns to about 300 microns.

Claims 77-86 (canceled without prejudice or disclaimer).

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87: The substrate of any one of claims 57-63 and 73 wherein said composition is a product produced by the process of combining said superabsorbent polymer with said material for lubricating a surface.

88: The method of any one of claims 65-71 and 76 wherein said composition is a product produced by the process of combining said superabsorbent polymer with said material for lubricating a surface.

89: The substrate of one of claims 57-63 and 73 wherein said composition protects said substrate from the affects of water or water migration.

90: The substrate of claim 87 wherein said composition protects said substrate from the affects of water or water migration.

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91: The substrate of one of claims 57 or 65 wherein said :

(1) lubricating metal and alloy thereof, lubricating metal chalcogenide halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant comprises;

molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, cadmium oxide, borax, basic white lead, lead carbonate, lead monoxide, lead iodide, asbestos, talc, mica, zinc oxide, zinc phosphate, iron phosphate, manganese phosphate, carbon, graphite, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, or the Group VIII noble metals or mixtures thereof.

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(ix) Evidence appendix

Appellant did not present any evidence to the examiner in the prosecution of this application, but at this time attaches a photocopy of the first two pages of the August 12, 2002 certified interference notice as placed on the PTO file jacket of application Serial No. 08/943,125.

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(x) Related proceedings appendix

Appellant attaches a copy of the Board's February 27, 2006 decision in application Serial No. 08/943,125 and a certified copy of the file jacket of application Serial No. 08/943,125 showing the Patent and Trademark Office labeled it as an application involved in an interference. Appellant submitted a copy of the file jacket of application Serial No. 08/943,125 to the Board in that appeal.

PM 284278

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

August 21, 2000

**THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE
RECORDS OF THIS OFFICE OF:**

A COPY OF THE COVER JACKET ONLY.

SERIAL NUMBER: 08/943,125

FILING DATE: October 03, 1997

**By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS**



L. Edele

**L. EDELEN
Certifying Officer**

BEST AVAILABLE COPY

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

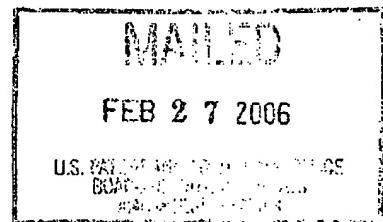
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD LEVY

Appeal No. 2005-2667
Application 08/943,125

ON BRIEF:



Before PAK, WARREN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER VACATING ORAL HEARING

On January 25, 2006, Mr. Craig R. Feinberg, a Program and Resources Administrator of the Board of Patent Appeals and Interferences, informed appellant's counsel, Mr. Robert J. Eichelburg, that the Merits Panel assigned to this application had decided to reverse the decision of the examiner. Mr. Feinberg further informed Mr. Eichelburg that therefore, the Oral Hearing scheduled for January 25, 2006, will be vacated.

Accordingly, as counsel was informed on January 25, 2006, it is ORDERED that the Oral Hearing scheduled for 1:00 PM on January 25, 2006, is *VACATED*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, and based on our review, find that we cannot sustain the rejection of appealed claims 43, 44, 49, 50, 55 and 56 under 35 U.S.C. § 102(b) as being anticipated by the Geursen et al. (Geursen) references

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United States Patent 5,534,304 ('304 reference) and WO 93/18223 ('223 reference)¹, which are in the same patent family (answer, pages 3-5 and 6-7).^{2,3}

We refer to the answer and to the brief and reply brief for a complete exposition of the positions advanced by the examiner and appellant.

It is well settled that the examiner has the burden of making out a *prima facie* case of anticipation in the first instance by pointing out where each and every element of the claimed invention, arranged as required by the claim, is described identically in a single reference, either expressly or under the principles of inherency, in a manner sufficient to have placed a person of ordinary skill in the art in possession thereof. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Whether the teachings and inferences that one skilled in this art would have found in the disclosure of an applied reference would have placed this person in possession of the claimed invention, taking into account this person's own knowledge of the particular art, is a question of fact. *See generally, In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), and cases cited therein (a reference anticipates the claimed method if the step that is not disclosed therein "is within the knowledge of the skilled artisan."); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968) ("[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom."). While it is entirely appropriate to rely on another reference to clarify a fact in the anticipating reference; *see generally, In re Samour*, 571 F.2d 559, 562, 197 USPQ 1, 4 (CCPA 1978), the supporting reference must in fact accomplish that purpose.

The principal issue in this ground of rejection is whether the lubricating compositions

¹ The answer incorrectly identifies the '223 reference as "WO 93/18233."

² The examiner withdrew the ground of rejection of appealed claims 45 through 48, 51 through 54, 57 and 58 under 35 U.S.C. § 103(a) as being unpatentable over the Geursen et al. references further in view of the admitted prior art and Sayad et al., set forth in the Office action mailed May 24, 2002 (pages 5-7) and maintained in the Office action mailed December 18, 2003. The examiner objected to these claims as containing allowable subject matter but dependent on a rejected base claim (answer, page 2). We consider the ground of rejection under the judicially created doctrine of obviousness type double patenting below.

³ Claims 43 through 48 are all of the claims in the application. *See* page 2 and the appendix of the brief filed March 13, 2003, which we consider on appeal.

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containing any "superabsorbent polymer which absorbs greater than about 100 times its weight in water" in the claimed method of lubricating a surface, encompassed claim 43, and the lubricating compositions containing any "superabsorbent polymer which absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof" in the claimed method of lubricating a surface, encompassed in the remainder of the rejected claims, would have been described to one skilled in this art within the meaning of § 102(b) by the Geursen references.

The examiner takes the position that the Geursen references teach compositions which contain "a superabsorbent material" that is disclosed to be "capable of absorbing and holding a comparatively large quantity of water" which can be made from absorbent derivatives of polyacrylic acid including homo- and copolymers derived from acrylic acid and acrylamide (answer, page 3) ('223 reference, page 6, ll. 5-32; '304 reference, col. 3, ll. 33-67). In the statement of the ground of rejection, the examiner does not identify any specific polymer disclosed *per se* in the Geursen references as meeting the subject claim limitations, but contends that

Geursen incorporates the teachings of Arroyo et al (Arroyo) EP 0,351,100^[4,5] that the [superabsorbent material] includes the ARIDALLTM polymers that are known to absorb greater than 100 times its weight in water. Appellant makes admission on record at page 21 to the bridging paragraph of pages 22-23 of the instant specification that conventional known [superabsorbent material] that absorbs greater than 100 times its weight in water of the Admitted Prior Art are the [superabsorbent material] used in the instant claims. Appellant makes admission on record at line 17 of [page 22] of the instant specification that the ARIDALLTM POLYMERS of the Admitted Prior Art of Arroyo is the [superabsorbent material] used in the instant claims. [Answer, page 4.]

Contrary to appellant's contentions (brief, page 14; reply brief, page 2), the Geursen references teach that insoluble superabsorbent materials that can be used include those "mentioned in . . . [Arroyo]" which are described as "derived from an aqueous solution comprising an acrylate polymeric material which combines acrylic acid and sodium acrylate

⁴ European Patent Application published January 17, 1990.

⁵ We cannot find Arroyo in a PTO-892, a PTO-1449 or elsewhere in the official electronic file of the USPTO for this application. Thus, if the examiner cannot locate evidence in the official electronic file of the USPTO for this application that Arroyo was made of record, the examiner should make it of record.

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functionalities and water" ("223 reference, page 2, ll. 10-17, and page 6, ll. 9-11; '304 reference, col. 1, ll. 45-53, and col. 3, ll. 37-40). We find that Arroyo describes superabsorbent materials generally, including those based on polyacrylic acid and polyacrylonitrile, and discloses that "[t]he preferred superabsorbent material is Aridall™ 1125F Superabsorbent Polymer available from the Chemdal Corporation," and that "Aridall polymers are crosslinked acrylic polymers" (col. 5, l. 35, to col. 7, l. 1).

Appellant discloses in the written description in the specification that "[t]he superabsorbent polymer employed according to the invention, absorbs from about 25 to greater than 100 times its weight in water and comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile or acrylamide, including co-polymers thereof or starch graft copolymers thereof or mixtures thereof, where the mixtures contain from 2 to about 3 or 4 superabsorbent polymers" (page 21, ll. 1-7). Appellant further discloses that the superabsorbent polymers include those listed in certain United States Patents as well as certain commercially available polymers (pages 21-23). Included among the latter is "Aridall™ which are sodium or potassium polyacrylates that may be lightly cross-linked" (page 22, ll. 17-18).

Appellant argues in the brief that the "swelling value" disclosed in Geursen references includes "the relative water absorbency of the yarn or the yarn coated with the superabsorbent polymer composition," and provides a supporting explanation based on the disclosure in Example I, including Table A, of the references for the contention that the same would not have disclosed "superabsorbent polymers that can absorb greater than about 100 times their weight in water" (brief, pages 6-10 and 12; see reply brief, page 6). The composition includes "Mirox W 45985" which is a superabsorbent polymer that "is a terpolymer of acrylamide, carboxyl groups- and sulfo groups-containing polymers" ('223 reference, pages 15-17; '304 reference, cols. 8-9).

In response to appellant's arguments in the brief, the examiner points to the disclosure in the Geursen references that "[d]epending on the nature of the substrate and the quantity and nature of the superabsorbent material applied thereto, the swelling values ranges from 50 to 700 or higher, more particularly from 100 to 700 or higher" ('223 reference, page 2, ll. 10-17, and page 6, ll. 9-11; '304 reference, col. 7, ll. 2-6) (answer, page 6).

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Appellant points out in the reply brief that "neither[the Geursen references] nor Arroyo claim that the ARIDALL™ 1125F disclosed in Arroyo can absorb greater than 100 times its weight in water," and that this material is not disclosed in his specification (pages 3-4).

Appellant states that "an internet search" did not "find" this material (*id.*, page 3).

On this record, we agree with appellant that the examiner has not identified any evidence in the Geursen references and Arroyo which support the ground of rejection. In order to factually support the ground of rejection, the examiner must establish as a matter of fact that at least one superabsorbent material in the references met the subject claim limitations in the appealed claims. This cannot be accomplished by combining a disclosed general range of absorbent values of superabsorbent materials which overlaps the claimed absorbent range of "greater than about 100 times its weight in water," with a particular superabsorbent material, and especially since there is no disclosure in any of the references or in appellant's specification which would place the particular species within the claimed absorbent range, either expressly or under the principles of inherency. See *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 780, 227 USPQ 773, 777 (Fed. Cir. 1985) ("[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed."). Therefore, the examiner has not established a *prima facie* case of anticipation under 35 U.S.C. § 102(b) as a matter of fact and accordingly, we reverse this ground of rejection.

Other Issues

Upon further consideration of the appealed claims by the examiner subsequent to the disposition of this appeal, the examiner should consider whether the Geursen references alone (see, e.g., Geursen '223, page 5, l. 19, to page 6, l. 32, and page 12, l. 18, to page 13, l. 3), or together with appellant's admissions in the specification (page 21, l. 1, to page 23, l. 4), which suggest that superabsorbent materials that absorb greater than about 100 times their weight in water were known, affect the patentability of the claimed invention under 35 U.S.C. § 103(a).

REMAND TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §1.41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 2, May 2004; 1200-29 – 1200-30).

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The examiner provisionally rejected appealed claims 43 through 57⁶ under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 72 through 86 of then copending application 08/943,123 (answer, pages 5-60). This application has since matured into United States Patent 6,734,147 ('147 patent), issued May 11, 2004.

Appellant filed a terminal disclaimer along with the reply brief on December 8, 2003, "to overcome the double patenting rejection" (reply brief, page 9). The examiner acknowledged that the terminal disclaimer "is proper and has been entered into the file," but did not state the status of the ground of rejection in view thereof in the communication mailed February 27, 2004.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to determine whether the terminal disclaimer overcomes the ground of rejection, and if not, to state the ground of rejection based on the appealed claims vis-à-vis the claims of the '147 patent, setting forth the status of appealed claim 58 in this respect, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This remand is made for the purpose of directing the examiner to further consider the ground of rejection. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, "appellant must within two months from the date of the supplemental examiner's answer exercise one of" the two options set forth in 37 CFR §1.41.50(a)(2) (2005), "in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

⁶ The examiner did not include appealed claim 58 in this ground of rejection (answer, page 5; Office action mailed May 24, 2002, page 7; Office action mailed December 18, 2003, page 3), and thus this claim stands unrejected on appeal.

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Reversed

Remanded

CHUNG K. PAK
Administrative Patent Judge

Administrative Patent Judge


CHARLES F. WARREN
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

PETER F. KRATZ
Administrative Patent Judge

**BOARD OF PATENT
APPEALS AND
INTERFERENCES**

Application No. 10/614,114
Brief on Appeal
Dated: June 5, 2006

CERTIFICATE OF FACSIMILE TRANSMISSION PURSUANT TO 37 C.F.R. § 1.6 (d)

I hereby certify that this correspondence is being transmitted pursuant to 37 C.F.R. § 1.6(d) by facsimile to The United States Patent and Trademark Office, facsimile telephone number (571) 273-8300 on the date indicated below.

By: /Robert J. Eichelburg, Reg. No. 23,057/
Robert J. Eichelburg

Dated: June 6, 2006